

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACKIE R. BOYLES, JAMES R. STOY
and JAMES L. G. SCHRODT

Appeal No. 97-2418
Application No. 08/390,843¹

ON BRIEF

Before McQUADE, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, which are all of the claims pending in this application.

¹ Application for patent filed May 1, 1995. According to the appellants, the application is a continuation-in-part of Application No. 08/209,349, filed March 14, 1994, now abandoned.

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We AFFIRM.

BACKGROUND

The appellants' invention relates to a device for assuring equal distribution of two phase flow at piping junctions (specification, p. 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced infra.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Bachmann et al.	4,919,169	April 24,
1990		
(Bachmann)		

Claims 1 through 3 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which the appellants regard as their invention.

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bachmann.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed November 27, 1996) and the examiner's response to the remand by the Board of Patent Appeals and Interferences (Paper No. 19, mailed April 9, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 11, filed July 22, 1996) and reply brief (Paper No. 16, filed January 27, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 112, second paragraph, Rejection

We will not sustain the rejection of claims 1 through 3 under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which the appellants regard as their invention.

The examiner determined (answer, pp. 3-4) that a statement made by the appellants in the brief was evidence that claims 1 through 3 fail to correspond in scope with what the appellants regard as the invention. We do not agree. The mere fact that the appellants utilized different language in their brief (see the summary of the invention on page 2 of the brief) to describe the invention than the language utilized in the claims under appeal is insufficient to establish that the claims under appeal fail to set forth the subject matter which the appellants regard as their invention. Accordingly, the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 112, second paragraph, is reversed.

The 35 U.S.C. § 102(b) Rejection

We sustain the rejection of claims 1 through 3 under 35 U.S.C. § 102(b) as being anticipated by Bachmann.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claim 1 recites:

Apparatus for assuring the equal phase distribution and steam quality of a two phase mixed steam flow having a gaseous phase and a liquid phase, in a steam flow line having a junction inlet and two junction outlets, and for distributing said two phase mixed steam flow in a preselected distribution ratio between said two junction outlets, the apparatus comprising

steam flow diverting means movably arranged at said junction inlet for diverting alternately all of said two phase mixed steam flow to a selected one of said two junction outlets; and

means for controlling movement of said fluid flow diverting means to deliver said two phase mixed steam flow in said flow line alternately to each of said two junction outlets to achieve said preselected distribution ratio of said two phase mixed steam flow between said two junction outlets.

The examiner determined (answer, p. 3) that

[t]he claim [claim 1] is interpreted as being drawn to a diverter, which Bachmann et al. show [sic]. The recitations "steam" merely relate to intended use and are given no weight. The gas turbine exhaust is read as a two phase fluid in that the products of combustion include water and gases. In the alternative, it can be seen that when the valve of Bachmann et al is used in an environment which includes two phase fluid, such as wet steam, it will meet the claims.

The appellants argue (brief, pp. 3-5) that (1) the

Examiner has ignored most of the limitative language of claim

1 in that the Examiner took the position that he interpreted the claim as being drawn to a diverter valve and gave no weight to the recitations of two phase mixed steam flow, (2) without extensive testing the appellants have no way of determining the Examiner's assumption that the diverter valve of Bachmann would be useful in any sense in a two phase steam flow line, and (3) at no point does Bachmann even discuss two phase, single phase or any steam flow, much less a means for controlling movement of two phase steam as called for in claim 1.

We conclude that the examiner has established a prima facie case of anticipation.² When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the

² It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

teachings of the applied prior art. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990). In this case, Bachmann clearly describes a gas flow diverter having all the structural features recited in claim 1 (e.g., a flow line having a junction inlet and two junction outlets, a flow diverting means, and means for controlling movement of the flow diverting means). Bachmann's gas flow diverter is designed to transport a large volume of hot exhaust gas from a gas turbine 11 to either a heat recovery steam generator 12 or a stack 13 (see Figure 1 and column 3, lines 33-38). Thus, it is our opinion that it would have been reasonable to assume that Bachmann's gas flow diverter is capable of distributing two phase mixed steam flow. While of course there is no teaching in Bachmann of using the gas flow diverter in this manner, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists whether there was a recognition that it could be used to perform the claimed function. See, e.g., In re Schreiber, 128 F.3d 1473, 1477, 44

USPQ2d 1429, 1431-32 (Fed. Cir. 1997). See also LaBounty Mfg. v. Int'l Trade Comm'n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992) (in quoting with approval from Dwight & Lloyd Sintering Co. v. Greenawalt, 27 F.2d 823, 828 (2d Cir. 1928)):

The use for which the [anticipatory] apparatus was intended is irrelevant, if it could be employed without change for the purposes of the patent; the statute authorizes the patenting of machines, not of their uses. So far as we can see, the disclosed apparatus could be used for "sintering" without any change whatever, except to reverse the fans, a matter of operation.

Here, the question of whether Bachmann's diverter is or might be used to distribute two phase mixed steam flow, merely depends upon the performance or non-performance of a future act of use, rather than upon a structural distinction in the claims. Stated differently, the diverter of Bachmann would not undergo a metamorphosis to a new diverter simply because it was used to distribute two phase mixed steam flow instead of gas. See In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974) and Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

After the PTO establishes a prima facie case of anticipation based on inherency, the burden shifts to the appellants to prove that the subject matter shown to be in the prior art does not possess the characteristics of the claimed invention. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Hence, appellants' burden before the PTO is to prove that Bachmann's diverter does not perform the functions defined in claim 1. The appellants have not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971). Appellants' mere argument on pages 3-5 of the brief to the effect that Bachmann does not disclose distributing two phase mixed steam flow is not evidence. See In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974)(attorney's arguments in a brief cannot take the place of evidence). In addition, while it may be true that without extensive testing the appellants have no way of determining that the diverter valve of Bachmann would be useful in any

sense in a two phase steam flow line, it is the appellants' burden to prove that Bachmann's diverter does not perform the functions defined in claim 1.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is affirmed.

The appellants have grouped claims 1 through 3 as standing or falling together.³ Thereby, in accordance with 37 CFR § 1.192(c)(7), claim 2 and 3 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2 and 3 under 35 U.S.C. § 102(b) is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 112, second paragraph, is

³ See page 3 of the appellants' brief.

reversed; and the decision of the examiner to reject claims 1 through 3 under 35 U.S.C. § 102(b) is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

JVN/gjh

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APPLICATION NO. 08/390,843

APJ NASE

APJ CRAWFORD

APJ McQUADE

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: 10 Dec 98

FINAL TYPED: